

## **REMARKS**

### **Summary of the Office Action**

Claims 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,398,214 to *Motek et al.* ("*Moteki*").

Claims 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,220,592 to *Watanabe et al.* ("*Watanabe*").

Claims 1, 3-5, and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of U.S. Patent No. 6,371,471 to *Fukazu et al.* ("*Fukazu*").

### **Summary of the Response to the Office Action**

Applicant cancels claims 6 and 8 without prejudice or disclaimer. Claims 2, 7, 9-11, and 15-23 have been cancelled, without prejudice or disclaimer. Accordingly, claims 1, 3-5, and 12-14 are presently pending.

### **All Subject Matter Complies with 35 U.S.C. § 102(b)**

Claims 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Moteki*, and claims 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Watanabe*. Applicant respectfully submits the rejections are moot in light of the cancellation of claims 6 and 8.

### **All Subject Matter Complies with 35 U.S.C. § 103(a)**

Claims 1, 3-5, and 12-14 stand rejected 35 U.S.C. § 103(a) as being unpatentable over *Watanabe* in view of *Fukazu*. Applicant respectfully traverses the rejection for at least the following reasons.

The Office Action has not established a *prima facie* case of obviousness at least because *Watanabe* and *Fukazu*, whether alone or in combination, fail to teach or suggest all the recited

features of independent claims 1 and 12. Independent claim 1 recites, in part, “advancing and retracting operations of said pressing member vary according to whether or not folding is performed on sheets newly supplied to said compiling tray; said pressing member is provided at a downstream side of a supplying direction of said sheets above said compiling tray.” Similarly, independent claim 12 recites, in part, “a conveyance force of said second moving-aside unit is used for moving said sheets aside toward said longitudinal reference wall, and set therein in such a way as to be variable; and said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on said compiling tray.” *Watanabe* or *Fukazu*, whether taken alone or in combination, fail to teach or suggest at least these features of claims 1 and 12.

The Office Action takes the position, with respect to independent claims 1 and 12, that the secondary reference *Fukazu* teaches a folding device and that it would be obvious to one of ordinary skill in the art at the time the invention was made to combine *Fukazu* with *Watanabe*, because *Watanabe* teaches that positioning occurs according to the height of the sheets on tray 12. But this is not the same thing as “advancing and retracting operations of said pressing member vary according to whether or not folding is performed on sheets newly supplied to said compiling tray,” as recited in claim 1 or “said second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on said compiling tray,” as similarly recited in independent claim 12. The height of the sheets is not the proper consideration, but the folding of the sheets is.

Further, the Office Action states “*Watanabe et al.* does not specifically show that the second moving-aside unit is set in a manner that varies according to whether or not folding is performed on sheets stacked on the compiling tray.” See page 6, lines 15-18 and page 9, lines

10-13 of the Office Action. It relies upon *Fukazu* for this teaching. Contrary the assertions in the Office Action, *Fukazu* does not provide this teaching either. Applicant respectfully requests that the Examiner provide reference to *Fukazu* where it is taught that the moving-aside unit varies according to whether or not folding is performed. Assumptions are not evidence of this teaching, and the assumption that folding results in thicker sheets and thus the height of the sheets is ultimate consideration is false. Assuming that the height of sheets by an unknown number of *e.g.*, Z-letter, half-fold, or C-letter folded sheets is sufficient to vary the pressing member height is ridiculous on its face. Accordingly, *Watanabe* fails to teach or suggest each and every feature of claim 12. *Fukazu* does not cure this deficiency in *Watanabe*. Thus, the rejection of claim 12 should be withdrawn.

As pointed out in M.P.E.P. § 2143.03, all the claimed limitations must be taught or suggested by the prior art to establish *prima facie* obviousness of a claimed invention. Because *Watanabe* and *Fukazu*, whether taken alone or in combination, fail to teach or suggest each feature of independent claims 1 and 12, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, claims 3-5 and 13-14 depend from one of independent claims 1 or 12. Accordingly, claims 3-5 and 13-14 are also allowable because of the additional features they recite and the reasons stated above.

### CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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